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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,479	12/13/2001	Georg Wurm	60,130-1303; 01MRA0194	3653

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/023,479	Applicant(s) WURM ET AL.	
	Examiner Marc Jimenez	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,16,17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,16,17 and 19-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 16, 17 and 25-27** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 16 recites “painting a door outer panel” in line 2. There is no support in the original disclosure of this limitation. In reading the specification, page 9, paragraph [79] describes that the door outer panel can be provided at the car manufactures assembly line where it can be painted to ensure uniform color. Paragraph [82] describes that the door outer panel may have different colors. However, there is no mention of painting the door outer panel as recited in the claims. Applicant’s argument that the references applied do not teach “... the step of painting an outer door panel before the step of fitting the door outer door panel to an inner door panel” was previously noted in the last office action (see office action filed 9-6-05). It is also noted that in the most recent response filed 1-4-06, applicant states that “, ...the claimed invention recites method steps in a specific order.” (page 7, line 1). However, Applicant has not yet provided a citation where support for this limitation can be found in the original disclosure. In reviewing the original disclosure, the feature of painting the outer door panel before fitting and assembling the

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outer panel could not be found and is therefore considered new matter. Please provide a citation, if any, in the original disclosure where there is support for the limitation “painting a door outer panel” prior to “assembling at least one functional component onto an outer face of a door inner panel” as recited in claim 16.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 4-8, 19, 20, 22-24, and 29** are rejected under 35 U.S.C. 102(e) as being anticipated by Palazzolo et al. (US6164716).

Palazzolo et al. teach a method of assembling a door comprising the steps of assembling a window regulator assembly and a window glass **60** onto an outer face of a door inner panel **22**, the door inner panel **22** also including an inner face, assembling an anti intrusion beam **66** directly onto the outer face of the door inner panel **22**, assembling a door outer panel **24** towards the outer face of the door inner panel **22**, and securing by fixing the door inner panel **22**, the window regulator assembly **60**, the anti intrusion beam **66** and the door outer panel **24** relative to each other, wherein the step of assembling the window regulator assembly and the window glass

60 precedes the step of assembling the anti intrusion beam **66** which precedes the step of assembling the door outer panel **24**.

Regarding claim 4, a trim panel (see to the left of **22** in figure 2) is assembled towards the inner face of the door inner panel **22** and securing the trim panel to the door inner panel.

Regarding claims 5-6, note the fixing element at **34** or **54** in figures 6 and 7 which includes a primary axis which is substantially perpendicular to the outer face of the inner door panel **22**.

Regarding claims 7-8, see figures 6-7 for the step of securing including a primary fixing direction which faces the outer face of the door inner panel **22**. Note that the fixing is non destructive.

Regarding claims 19-20, the anti intrusion beam **66** is configured to inhibit intrusion of other vehicles into the vehicle and the door inner panel includes a leading edge, trailing edge, waste line and bottom edge, and the anti intrusion beam is an elongate member.

Regarding claim 22, the anti intrusion beam is secured directly to the outer face of the door inner panel (see figures 6-7).

Regarding claims 23-24, note the fixing element at **34**.

Regarding claim 29, the outer door panel is supported entirely by the door inner panel at crimp **40**.

5. **Claims 16, 17, 21, and 25-27** are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Palazzolo et al.

Palazzolo et al. teach a method of assembling a door comprising the steps of:

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assembling at least one functional component **60** onto an outer face of the door inner panel **22**, the door inner panel **22** also including an inner face, assembling an anti intrusion beam **66** onto the outer face of the door inner panel separately from the other door components, and assembling a door outer panel **24** towards the outer face of the door inner panel **22** separately from the other door components, and assembling a door outer panel **24** towards the outer face of the door inner panel **22**, wherein the step of assembling the anti intrusion beam **66** precedes the step of assembling the door outer panel **24**, and wherein the at least one functional component comprises at least one of a window regulator assembly, a loudspeaker and a latch assembly **60**.

It is inherent that the door outer panel **24** is painted because doors are painted so that they match the desired color of the body of the vehicle.

Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided the invention of Palazzolo et al. with painting the outer door panel, in order to match the color of the door to the vehicle body.

6. **Claim 28** is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Palazzolo et al.

It is inherent that the window regulator assembly **60** shown in figure 2 is assembled with the glass before assembling the window regulator assembly and the window glass onto the outer face of the door inner panel because window assemblies and window glass are subassemblies that are typically assembled together. Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have assembled the window glass to the window regulator assembly before assembling it to the door inner panel, in

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order to facilitate easier assembly of the window regulator assembly and the window to the door inner panel.

Response to Arguments

7. Applicant's arguments filed 1-4-06 have been fully considered but they are not persuasive.

8. Applicant's arguments, see page 6, second and third full paragraph, filed 1-4-06, with respect to the rejection of claim 29 under 35 USC 112 1st paragraph have been fully considered and are persuasive. The rejection of claim 29 under 35 USC 112 1st has been withdrawn.

Applicant has clarified that the door outer panel is entirely supported by the door inner panel by a hem attachment. It is noted that the prior art reference US 6,164,716 to Palazzolo et al. also shows this in figure 7.

9. Regarding claims 1, 4-8, 19, 20, 22-24 and 29, Applicant argues that the element **66** in figure 2a of Palazzolo et al., identified in the last office action, cannot be considered an "anti intrusion beam". However, in as much structure claimed, the structure **66** is considered to be an anti intrusion beam. As evident by its cross-section in figures 6-7, the structure **66** is made of metal and can help protect a passenger against intrusion of another vehicle or object. Although shown in figure 2a as a rectangular one piece structure including portions **52 and 54**, the element **66** is considered a beam similar to the beam **6** shown in figure 1 of Pacella et al. A beam does not have to be thin in width or depth or have a particular structure. Applicant argues that the claimed invention recites method steps in a specific order and that Palazzolo does not disclose any specific order of assembly for the various components. However, as clearly shown in figure 2a,

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the various components are assembled as claimed. Furthermore, claim 1 is written in open-ended format (ie. "comprising the steps of:") and does not require specific steps to be performed in a particular order. The order of steps has been deleted in a previous amendment. See the claim amendment filed 3-10-05 which shows proper order of steps.

10. Applicant's arguments with respect to claims 16, 17, 21 and 25-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

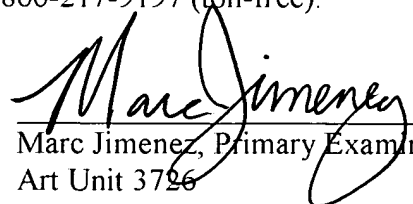
Interviews After Final

12. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Marc Jimenez, Primary Examiner
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